

Serial Number. 10/613,205Docket Number. 200300091-1**REMARKS**

Upon entry of this Response, claims 10-13, 15-20, and 24-29 remain pending in the present patent application. Claims 1-9, 14, and 21-23 are now canceled. Claims 1-9, and 21-23 are canceled, without prejudice, based on an election to a restriction requirement made in the Response filed on 12/20/2004. The subject matter of claim 14 has been incorporated into claim 10. Claims 10, 15-17, and 24-25 have been amended. Claim 29 which is objected to is now rewritten in independent form to include the subject matter of the originally-written claim 24. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

The informality noted in item 2 of the Office Action has been corrected and the "the" has been changed to "a".

Claims 10-13, and 24 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ito et al. (U.S. Pat. No. 5,402,212). Applicants have amended claim 10 to incorporate subject matter of claim 14, and claim 24 to incorporate subject matter of claim 25. It is believed that the claim rejections under 35 U.S.C. §102(b) are overcome by these amendments.

Claims 14-17, 20, 25, have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ito et al. (US Patent No. 5,402,212) in view of Kalyandurg et al. (US Patent No. 5,132,732).

Applicants respectfully disagree. The Examiner has not established a prima facie case of obviousness because the Examiner has not established a valid motivation that has been cited in the references to modify or combine the reference disclosures to produce the claimed invention.

In item 6 of the Office Action the Examiner stated:

"By combining the two references, it would be possible for a user to manipulate the lever or eject button taught in Ito to engage with the mount/dismount apparatus taught by Kalyandurg so that the lever begins to move along the z-axis, and engaging the platform assembly by movement of the lever assembly, and the platform will move in a direction substantially orthogonal to a front side (i.e. first side) of the printer. One of ordinary skill in the art would have been motivated to use the particular dismount/mount apparatus and method as taught by Kalyandurg to modify Ito because it provides a simple and easy mounting system that includes

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precise dual axis displacement of the development unit or process cartridge (Kalyandurg col. 2, lines 1-8).

Ito et al. discloses an image forming system in which the insertion and ejection of the cartridge in and out of the image forming system, respectively, is effectuated by electrically controlled rollers which achieve the objective of reducing an operator's burden and relieving the shock against the cartridge. (Col. 1, line 67 to col. 2, line 4; Col. 4, lines 7-17, 32-43, 53-56; Col. 10, lines 34-36).

Kalyandurg et al. discloses an electrostatographic reproduction apparatus that houses a mounting system which is firmly attached to the frame and serves to interface a development unit with respect to an image-bearing member (col. 4, lines 46-53). The development unit can be precisely moved relative to the image-bearing member within a desired proximity to the latent images on the image-bearing member (col. 4, lines 20-26) to avoid overloading against the image-bearing member and toner dusting which decreases the quality of the images developed (col. 1, lines 57-62; col. 8, lines 63-66).

Applicants submit that proposed modification of Ito et al. in which the automated rollers and guides would be replaced by the platform and lever assembly of Kalyandurg et al. would render Ito et al. unsatisfactory for its intended purpose. The placement of the platform and lever assembly of Kalyandurg et al., which functions to move the development unit between a lowered and an upraised position inside the electrostatographic reproduction apparatus, would not accomplish the insertion and ejection of the development unit in and out of the image forming device of Ito et al. If the proposed modification would render the reference being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 citing, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The dual-axis lifting mechanism of a development unit disclosed Kalyandurg et al. is unrelated to the automatic insertion and ejection of a cartridge in Ito et al., and the proposed modification would change the principle of operation of the invention being modified. The proposed substitution would require a substantial redesign and a change in the basic principle under which Ito et al. was designed to operate to automatically advance and eject the cartridges to alleviate shock against the cartridges. MPEP 2143.01, citing, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (COPA 1959).

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Furthermore, there is no indication, either explicit or implicit, in the references that suggest the desirability and thus the obviousness of making the Examiner's proposed combination. Even in a case where the references can be combined or modified, the resultant combination is not rendered obvious unless the references suggest the desirability of the combination. MPEP 2143.01, citing, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Applicants submit that the Examiner's stated rationale to combine the references is conclusory and was arrived at by hindsight reconstruction. As indicated above, the Examiner states that the "...the dismount/mount apparatus and method as taught by Kalyandurg ... provides a simple and easy mounting system that includes precise dual axis displacement of the development unit or process cartridge." However, there is no indication in that preciseness in ejection and insertion of the cartridge was a problem or that a dual axis displacement system is more precise than displacement via the electrically controlled rollers. Examiner must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious. Mere conclusory statements cannot be relied upon as motivation to combine or modify references. The rejection must set forth rationale upon which it relies. *In re Sang Su Lee*, 277 F.3d 1338; 61 USPQ2d 1430, (Fed. Cir. 2002). (Where knowledge is relied upon as motivation to combine, the knowledge must be articulated and placed on the record.)

Case law reiterates that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to comb in prior art references. It is well settled law that the prior art references must be examined such that their teachings are applied in the context of their significance without the benefit of suggestion provided by the present invention itself. Something within the references themselves and set apart from the instant invention must suggest the desirability and thus the obviousness of making the proposed combination.

For the reasons articulated above, Applicants believe that independent claims 10 and 24 are in condition for allowance, and therefore request that the rejection of claims 10 and 24 be withdrawn. Applicants believe that claims 11-13 and 15-20 which ultimately depend from independent claim 10 are allowable over the cited prior art references for the reasons discussed above with reference to claim 10 above. In addition, Applicants believe that claims 25-28 which ultimately depend from

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independent claim 24 are allowable over the cited prior art references for the reasons discussed above with reference to claim 24 above. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP 2143.03, citing, *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Applicants therefore request that dependent claims 11-13, 15-20, and 25-28 be allowed. As mentioned above, claim 29 which is objected to is now rewritten in Independent form, and Applicants respectfully request the allowance of claim 29.

### CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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